

1A 1A
UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1459
Alexandria, Virginia 22313-1459
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,008	11/15/2000	Johann Engelhardt	102847-28	1885

21710 7590 05/21/2003

BROWN, RUDNICK, BERLACK & ISRAELS, LLP.
BOX 1P, 18TH FLOOR
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER

FERNANDEZ, KALIMAH

ART UNIT

PAPER NUMBER

2881

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,008

Applicant(s)

ENGELHARDT, JOHANN

Examiner

Kalimah Fernandez

Art Unit

2881

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 8-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 8-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2,4-6, and 8-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 5,881,045 issued to Inoue and in view of US Pat No 6,275,454 issued to Boutaghou et al.
3. Inoue teaches a specimen (i.e. cd) receiving device for hold the specimens (i.e. cd) (col. 3, lines 1-20).
4. Inoue teaches said specimen receiving device being linearly displaceable via transport mechanism (col.3, lines 16-20; col.9, lines 40-67).
5. Inoue teaches said specimen receiving device being rotatable about the axis of rotation (col.5, lines 50-53).
6. Inoue teaches said scanning device (30) provided for optically scanning the specimen (col. 6, lines 5-7).
7. Further, Inoue teaches the use of a movable scanning device /optical head (col.6, lines 8-17).
8. Inoue does not explicitly teach said scanning device/optical head being linearly displaceable and being rotatable.

9. However, Boutaghou et al teaches a scanning device/ optical head which is both linearly displaceable and rotatable about an axis (16) of rotation (col.3, lines 18-42; see figs. 1-2).

10. It would have been obvious to one of ordinary skill in the art to combine the teachings of Inoue and Boutaghou et al since Boutaghou et al teaches an improved positioning mechanism (col.1, lines 35-44).

11. As per claim 2, Boutaghou et al teaches the specimen receiving device defines a rotation speed of the specimen and the scanning device remains substantially constant during a relative motion between the scanning device and the specimen-receiving device (col.3, lines 18-32).

12. As per claim 4, Boutaghou et al teaches a constant optical distance between a specimen and the scanning device (col.3, lines 29-32).

13. As per claim 5, Boutaghou et al teaches said specimen receiving device defines a rotation speed of the specimen receiving device, and the rotation speed is dependent on the relative position between the specimen receiving device and the scanning device (col.3, lines 27-32).

14. As claim 6, Boutaghou et al teaches the rotation speed is dependent on a detected data stream of the scanning device (col.3, line 62-col.4, line 5).

15. As per claims 8-12, Inoue teaches a replacable, single vessel/ carousel insert (i.e. cd) on a carriage (col.5, lines 22-41; col.5, lines 42-53).

16. As per claim 13, Boutaghou et al teaches an auto-focusing means (44) maintaining the specimen in focus (col.3, lines 43-51).

17. As per claim 14 and 19-20, Boutaghou et al teaches focusing a specimen.

Boutaghou et al does not teach the recited ranges; however, it is held that focal variables are result-effective variable. That is, the selection of the values of the recited focal variable will achieve an art-recognized result.

18. As per claim 15, Boutaghou et al teaches a laser source (58) and a detector (60) (col.3, lines 52-55).

19. As per claim 16, Boutaghou et al teaches said laser beam being scanned /deflected at least one directions (col.2, lines 52-64).

20. As per claim 17, Boutaghou et al teaches said laser beam is stationary relative to the scanning device (20) (col.3, lines 52-66; fig. 3).

21. As per claim 18, Boutaghou et al teaches said laser beam provided for scanning can be of different wavelengths (col.4, lines 16-20). Namely, Boutaghou et al teaches the ability to select different wavelengths depend on the mode of operation; therefore, Boutaghou et al teaches scanning in different wavelengths.

22. As per claim 21, Boutaghou et al teaches said laser beam defines an non-zero incidence angle on the surface of the specimen receiving device (see fig. 2).

23. As per claim 22, Boutaghou et al teaches synchronization markers provided on the specimen (col.4, lines 20-22).

Conclusion

24. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US pat No. 6,335,824 issued to Overbeck; US Pat No.

Application/Control Number: 09/681,008
Art Unit: 2881

Page 5

6,201,639 issued to Overbeck; US Pat No 6,239,426 issued to Muramatsu et al; US Pat No. 6,330,095 issued to Ozawa; US Pat NO 5,72,695 issued to Jehan et al; and US Pat No 6,484,602 issued to Dagalakis et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalimah Fernandez whose telephone number is 703-305-6310. The examiner can normally be reached on Mon-Thus between 8:30am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Lee can be reached on 703-308-4116. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

kf
May 12, 2003


JOHN R. LEE
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER 2800